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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PER SKJOLDAGER ANDERSEN
and OVE THORBJORN JENSEN

Appeal 2010-006335
Application 09/482,462
Technology Center 3600

Before: JOSEPH A. FISCHETTI, BIBHU R. MOHANTY, and
MICHAEL W. KIM, *Administrative Patent Judges.*

KIM, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 1-50¹. We have jurisdiction to review the case under 35 U.S.C. §§ 134 and 6 (2002).

The claimed invention is directed to an advertisement sales and management system and method, that provides a comprehensive advertising solution, which supports the integration of the total advertising workflow by handling all kinds of advertisements booked for one or multiple media (Spec. 1:5-8). Claim 1, reproduced below, is further illustrative of the claimed subject matter.

1. An advertisement sales and management system comprising:
 - (a) data storage means;
 - (b) data retrieval means;
 - (c) data processing means;
 - (d) database means; and
 - (e) a number of workstations, one or more of the workstations being adapted to perform one or more of tasks selected from a group consisting of:
 - (i) entering advertisement orders into the database means;
 - (ii) entering advertisement-associated data into the database means and retrieving advertisement-associated data from the database means;
 - (iii) entering customer-associated data into the database means and retrieving customer-associated data from the database means,

¹ We refer to the Appeal Brief filed May 24, 2004 (hereinafter “App. Br.”), Examiner’s Answer mailed June 14, 2004 (hereinafter “Exam’r’s Ans.”), Supplemental Examiner’s Answer mailed January 4, 2007 (hereinafter “Supp. Exam’r’s Ans.”); and Second Supplemental Reply Brief filed August 27, 2007 (hereinafter “Reply Br.”).

means being adapted to at least store and manage data relating to:

(f) an advertisement customer;

(g) an advertisement order comprising data related to an advertisement or a group of related advertisements including:

(i) a medium or media in which the advertisement or individual advertisement of the group of related advertisements is/are to be published;

(ii) a schedule or schedules defining insertions of the respective advertisements in respective media to control publication of the respective advertisements;

(iii) contents of respective advertisements;

(iv) presentation elements of respective advertisements,

the advertisement sales and management system being adapted to generate data defining the advertisement or the groups of related advertisements on the basis of entered order data,

the advertisement sales and management system thereby constituting a single system supporting entry, sales and management of several related advertisements in several media based on entry of a single advertisement order.

Claims 1-50 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Witek (US 6,253,188 B1, iss. Jun. 26, 2001) in view of *NEXPO '97*,

PART II: EDITORIAL AND ADVERTISING SYSTEMS, OTHER PRODUCTS, 26 Seybold Report on Publ'g Sys., 1-40 (Aug. 1997) (hereinafter “NEXPO”).

We AFFIRM-IN-PART.

ISSUES

Did the Examiner err in asserting that a combination of Witek and NEXPO renders obvious a system supporting “entry, sales and management of several related advertisements in several media based on entry of a single advertisement order,” as recited in independent claim 1?

Did the Examiner err in asserting that a combination of Witek and NEXPO renders obvious

[a]n advertisement sales and management system according to Claim 1, wherein the media comprise media selected from the group consisting of: (a) newspapers; (b) magazines; (c) paper books or electronic books; (d) electronic newspapers; (e) electronic magazines; (f) news streamers; (g) inserts; (h) onserts; (i) posters; (j) running message displays; (k) news banners; (l) TV; (m) movies; (n) data carriers such as CD ROMs, DVD discs, magnetic discs, DAT tapes; (o) videos; (p) radio; (q) stationary telephones; (r) mobile (cellular) telephones; (s) teletext; and (t) public data networks including the Internet[,]

as recited in dependent claim 7?

Did the Examiner fail to properly combine Witek and NEXPO to render obvious the subject matter of dependent claims 14, 15, 39, and 40?

Did the Examiner err in asserting that a combination of Witek and NEXPO inherently discloses

(a) retrieving contents and/or presentation elements associated with a previously stored insertion of the advertisement from the database means; (b) creating a version or versions of the previously stored advertisement by editing the retrieved contents and/or presentation elements;

and (c) storing the version or versions of the advertisement in the database means as corresponding material or materials[,]

as recited in dependent claim 23?

ANALYSIS

Independent Claim 1

We are not persuaded the Examiner erred in asserting that a combination of Witek and Nexpo renders obvious a system supporting “entry, sales and management of several related advertisements in several media based on entry of a single advertisement order,” as recited in independent claim 1 (App. Br. 12-19). Appellants assert that “the combination of Witek, et al. and NEXPO ‘97 adds nothing to the teaching of Witek et al. to overcome the shortcomings of Witek et al., namely--entry, sales and management of several related advertisements in several media based on entry of a single advertisement order” (App. Br. 13). However, the Examiner cites Witek for disclosing entry, sales and management of a *single* advertisement in a *single* medium based on entry of a *single* advertisement order. The Examiner then cites NEXPO for disclosing reusing content, thus modifying the single advertisement in the single medium of Witek into the claimed “*several* related advertisements in *several* media based on entry of a *single* advertisement order” (Exam'r's Ans. 4, 7) (emphasis added). Given that the Examiner has set forth a proper case of obviousness, we do not find Appellants' general argument of non-obviousness persuasive. *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (“[o]nce a prima facie case of obviousness [is] established ..., the burden shift[s] to appellant to rebut it”).

Appellants assert that

the combination of Witek et al. and NEXPO '97 completely fails to teach the administrative task of handling advertisement orders including entry, sales and management. Appellants respectfully submit that entry, sale and management include such administrative tasks as selling, defining, creating, pricing, accounting, customer contract handling, creating statistics, and sale automation, as set forth on page 4, lines 1-3 and 13-14 of the original specification.

(App. Br. 13-14). However, at least column 5, lines 28-31 and column 8, lines 60-61 of Witek disclose defining and creating ads, and column 56, lines 23-30 of Witek disclosing pricing ads. While Appellants may have intended for “entry, sale, and management” to include *all* of the tasks set forth above, such a requirement is not set forth in the claims. *See CollegeNet, Inc. v. ApplyYourself, Inc.*, 418 F.3d 1225, 1231 (Fed. Cir. 2005) (while the specification can be examined for proper context of a claim term, limitations from the specification will not be imported into the claims). Accordingly, under a broadest reasonable construction, if the prior art performs *some* of the recited tasks, as Witek does here, the aspect is met. *See In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (“[d]uring examination [of a patent application, a pending claim is] given [the] broadest reasonable [construction] consistent with the specification, and … claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art”) (internal citation and quotations omitted).

Appellants assert there is no motivation for combining Witek and NEXPO (App. Br. 14-15). However, given that the Examiner has explicitly set forth a rationale for combining on pages 4 and 8 of the Examiner's Answer, in the absence of specific, technical arguments as to why the motivation is insufficient, we find this argument unconvincing.

Appellants assert that Witek and NEXPO are not combinable because they are intended for use in different environments (App. Br. 15-17). Assuming Appellants are arguing that the references are not combinable because they are non-analogous art, a proper analogous arts analysis involves comparing each reference to the claimed invention. *See In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992) (the test for determining whether a reference is analogous art is (1) whether the reference is in the field of the appellant's endeavor or (2) whether the reference is reasonably pertinent to the problem with which the appellant was concerned). To that end, all of Witek, NEXPO, and the claimed invention are directed to digital entry and placement of advertisements in various media outlets, and thus are in the same field of endeavor, thus meeting the first prong of the analogous art analysis. Additionally, all of Witek, NEXPO, and the claimed invention are directed to solving complexity and time efficiency problems in advertising, thus meeting the second prong of the analogous art analysis (Witek, col. 1, ll. 40-58; NEXPO, p. 27; Spec. 1:29-35). Furthermore, not only do we find Appellants' argument that Witek is only applicable to online media and NEXPO is only applicable to print media overly restrictive, but are unpersuaded, absent the presentation of objective facts, that one of ordinary skill in one type of media would not look to another type of media for guidance.

To the extent that Appellants are arguing that Witek and NEXPO teach away from being combined with each other due to their intended use in different environments, neither Witek nor NEXPO disparages aspects of either each other or the claimed invention, as required for a teaching away. *See In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994) (“[a] reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant”). For these reasons above reasons, we consider that the Examiner to have established a *prima facie* case of obviousness.

We recognize that evidence of secondary considerations, such as that presented by the Appellants must be considered in route to a determination of obviousness/nonobviousness under 35 U.S.C. § 103. Accordingly, we consider anew the issue of obviousness under 35 U.S.C. § 103, carefully evaluating and weighing both the evidence relied upon by the Examiner and the objective evidence of nonobviousness provided by the Appellant. Appellants assert that the Declaration under 37 C.F.R. § 1.132 of Thomas Brandenborg provides objective evidence as to the non-combinability of Witek and NEXPO (App. Br. 18; Reply Br. 4). Paragraphs 5-9 and 24-25 declare an opinion as to what is included in the claimed invention, and paragraphs 12-16 declare an opinion that Witek does not disclose a system supporting “entry, sales and management of several related advertisements in several media based on entry of a single advertisement order.” None of this is in dispute.

Paragraphs 17-23 declare an opinion that Witek could not be combined with NEXPO. All the arguments set forth therein have been addressed above.

The Declaration filed under 37 C.F.R. § 1.132 has been fully considered, but is not deemed persuasive to show that the rejection of record is improper after evaluating and weighing all the evidence relied upon by the Examiner and provided by the Appellants.

Appellants assert that the Examiner's redefining of the term ““supporting,”” as recited in independent claim 1, as ““facilitating”” is improper (Reply Br. 2-3). Instead, Appellants assert that ““supporting’ a series of identified functions is a system that is capable of performing each of the identified functions.” As the Examiner has set forth a combination of Witek and NEXPO that is ““capable” of performing the functions set forth in the claim, we do not understand the relevance of Appellants’ distinction between ““supporting”” and ““facilitating.””

Appellants assert that “[**a**]llegations of [**g**eneric ‘[**e**]conomic [**a**]dvantages’ [**d**]oes [**n**]ot [**c**]onstitute [**m**]otivation” (Reply Br. 4-5). However, the “[**e**]conomic [**a**]dvantages” providing the rationale for the Examiner’s combination of Witek and NEXPO are not ““generic,” as page 27 of NEXPO explicitly discloses that the reuse of content results in the specific advantage of “easier production.”

Appellants assert that it is unclear whether Quark is valid prior art (Reply Br. 6-7). However, Quark is merely cited as background material, while the actual prior art applied in rejecting the claims is NEXPO (Exam'r's Ans. 7).

For the reasons set forth above, we also sustain the rejections of independent claims 19, 25, and 44 (App. Br. 19-20).

Dependent Claim 7

We are not persuaded the Examiner erred in asserting that a combination of Witek and NEXPO renders obvious

[a]n advertisement sales and management system according to Claim 1, wherein the media comprise media selected from the group consisting of: (a) newspapers; (b) magazines; (c) paper books or electronic books; (d) electronic newspapers; (e) electronic magazines; (f) news streamers; (g) inserts; (h) onserts; (i) posters; (j) running message displays; (k) news banners; (l) TV; (m) movies; (n) data carriers such as CD ROMs, DVD discs, magnetic discs, DAT tapes; (o) videos; (p) radio; (q) stationary telephones; (r) mobile (cellular) telephones; (s) teletext; and (t) public data networks including the Internet[.]

as recited in dependent claim 7 (App. Br. 21-22). Witek discloses that some of the media the classified ads may appear in include newspapers and electronic newspapers (col. 6, ll. 20-23; col. 48, l. 13; col. 56, ll. 8-10, 23-27). While Appellants may have intended for the system to support ads in all of the listed media, such a requirement is not set forth in the claims. *See CollegeNet, Inc. v. ApplyYourself, Inc.*, 418 F.3d at 1231. Accordingly, as the prior art includes at least one of the listed media, the aspect is met. *See In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d at 1364.

For the reasons set forth above, we also sustain the rejection of dependent claim 32 (App. Br. 22).

Dependent Claims 14, 15, 39, and 40

We are persuaded the Examiner failed to properly combine Witek and NEXPO to render obvious the subject matter of dependent claims 14, 15, 39, and 40 (App. Br. 22-23). We agree with Appellants that more than a reference to “the Internet (title)” of Witek is necessary to render obvious the specific and technical subject matter of dependent claims 14, 15, 39, and 40.

Dependent Claim 23

We are persuaded the Examiner erred in asserting that a combination of Witek and NEXPO inherently discloses

- (a) retrieving contents and/or presentation elements associated with a previously stored insertion of the advertisement from the database means; (b) creating a version or versions of the previously stored advertisement by editing the retrieved contents and/or presentation elements; and (c) storing the version or versions of the advertisement in the database means as corresponding material or materials[,]

as recited in dependent claim 23 (App. Br. 23-25). Even if content were to be reused, it is not necessarily true that either the content must be edited, or the edited content must be restored *in the database means*, as required for inherency. *See In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill).

For the reasons set forth above, we also do not sustain the rejection of dependent claim 49 (App. Br. 22).

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DECISION

The decision of the Examiner to reject claims 1-13, 16-22, 24-38, 41-48, and 50 is AFFIRMED.

The decision of the Examiner to reject claims 14, 15, 23, 39, 40, and 49 is REVERSED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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